

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested.

Claims 1 through 12 remain in the case. New claim 13 has been added. Claims 1 and 10 are in independent form.

§102 Issues

The Examiner rejected claims 1, 8, and 9 under §102 as being anticipated by Williams. Applicant respectfully asks the examiner to reconsider because Williams does not include on the palm the claimed “first indicia indicating that the person’s palm should not touch the ball.” The Examiner argues that the elimination of the bottom portion of the palm in Williams Fig. 6 is inherently capable of acting as the claimed indicia. But this is not supported and not logical for the following reasons.

First, there is no support for this position anywhere in Williams. Williams never says anything about the palm not touching the ball. Most of the other drawing figures show the palm touching the ball. The Examiner is improperly viewing the Williams patent with the teachings of the present invention in mind. There is nothing in Williams that would lead an objective reader to think that the palm should not touch the ball.

Second, the argument does not make sense. Figure 6 shows the top of the palm and the bottom left of the palm. It does not follow logically that because part of the palm is missing, that one should use none of the palm. Thus, at most, the Examiner’s argument could only be that the missing part of the representation of the palm is the part that should not touch the ball. But this makes no sense either; and it is not even physically possible to grip the ball in such a fashion – i.e. with part of the palm. Accordingly, this cannot be

the teaching from Williams. Accordingly, Claim 1 should be allowed, which allowance is respectfully solicited.

Dependent Claim 8 stands or falls with claim 1.

Dependent Claim 9 is patentable over Williams because it depends on Claim 1, which is patentable. In addition, Claim 9 defines patentable subject matter over Williams. Claim 9 recites a “universal finger on each side of the three middle fingers...” This is not shown in Williams, which teaches the need for both hands to be shown on the ball, where both of the hands include a clear thumb and a different clear pinkie finger – no universal fingers.

The Examiner cites the *Breslow* case against several of the claims. But *Breslow* does not apply to the present case. *Breslow* dealt with indicia that was not precise -- e.g. “indicia representative of experience or similar qualifications...” The holding in *Breslow* is fact-specific (“Any differences between appellants game and the Mitchell game ... are not considered patentable differences.”). This holding cannot be broadened to cover indicia that is precise – like the indicia in the present case. If it could, *Breslow* would prevent anyone from patenting useful articles that have instructive indicia disposed thereon; and that is clearly not the case. There are thousands of issued patents covering the use of instructive indicia on useful articles.

§103 Issues

The Examiner rejected Claims 2-4 and 10-12 under §103 as being unpatentable over Williams in view of Poegel, Jr. But the examiner did not make a *prima facie* case of obviousness, which requires at least two things: a showing of prior art that can be

combined to provide all of the claim limitations of the invention, and a suggestion in the prior art to make the combination. M.P.E.P. §706.02(J) Neither reference shows or suggests including “indicia indicating that the person should release the ball with the three middle fingertips of the release hand.” Poegel, Jr. has some indicia associated with the index finger. But Poegel does not say what the indicia means; and there is no other indicia. Poegel has no written description suggesting that Poegel’s indicia is supposed to mean that the person should release the ball with the three middle fingers. There is simply no teaching in Williams or Poegel to use indicia on the ball for indicating release with the three middle fingers. Because the combination of Poegel and Williams fails to provide all of the limitations of the claimed invention, the obviousness rejection is not proper. Moreover, the Examiner identified no suggestion in the art for making such a combination. Accordingly, claims 2-4 and 10-12 are allowable, which allowance is respectfully solicited.

Dependent claim 5 has been amended to recite that the legend is disposed on the ball. Claim 5 is allowable over the prior art because it is dependent on claims 1 and 2, which are allowable over the prior art. The amendment further overcomes the §103 rejection because there is no teaching in any combination of prior art to put the specific indicia and the legend on the ball. Nor is there any suggestion in the prior art to make such a combination.

Similarly, claim 6 has been amended to recite that the legend is disposed on the ball. Claim 5 is allowable over the prior art because it is dependent on claims 1, 2, and 3, which are allowable over the prior art. The amendment further overcomes the §103

rejection because there is no teaching in any combination of prior art to put the specific indicia and the legend on the ball. Nor is there any suggestion in the prior art to make such a combination. Accordingly, claims 5 and 6 are allowable, which allowance is respectfully solicited.

Claim 12 has been amended to recite that the ball is a basketball and the middle finger is the last to contact the ball. The Examiner rejected this claim under §103 because of Williams and Poegel. But both Poegel and Williams teach away from having the middle finger be the last finger to contact the basketball. Williams says that the "index finger 26 is the last contact point on the ball." (Col. 2, lines 32-33). Poegel shows the same thing. Accordingly, amended claim 12 defines over Williams and Poegel, and so amended claim 12 is allowable, which allowance is respectfully solicited.

New claim 13 recites subject matter that is patentable over the prior art. Allowance is respectfully solicited.

For the foregoing reasons it is believed that this Amendment places the claims now appearing in this case in condition for allowance, and an early notice to such effect is respectfully solicited.

In the event that the Examiner does not agree that the claims are now in condition for allowance, he is courteously invited to contact the undersigned at the number given below in order to discuss any changes which the Examiner believes would lead to an allowance of the claims.

It is not believed that any new fees are necessitated by the entry of this amendment. However in the event that any new fees or charges are required,

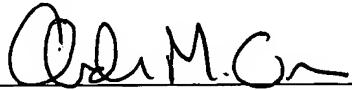
Amdt. dated November 1, 2004

Reply to Office action of October 1, 2004

authorization is hereby given to charge such fees to applicant's Deposit Account No 50-0852. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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Date: November 1, 2004